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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197005
Party	Plaintiff Gold Rush Brands, LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application Serial No. 77/931,658
For the Mark PAN AM & Design

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Gold Rush Brands, LLC,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No.: 91/197,005
	:	
Pan Am World Airways, Inc.,	:	
	:	
Applicant	:	
	X	

**OPPOSER’S MEMORANDUM OF LAW
IN OPPOSITION TO APPLICANT’S MOTION TO DISMISS**

Gold Rush Brands, LLC (“Opposer”), respectfully submits this brief in opposition to the Motion to Dismiss served by Applicant, Pan Am World Airways, Inc. (“Applicant”), on January 17, 2012.¹ Simply put, Applicant’s motion must be denied and the case must be permitted to proceed to discovery because Opposer has satisfied the liberal pleading standard applicable in Board proceedings by “stating a claim that is plausible on its face.” Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 503.02 (3rd Ed. 2011). Applicant’s arguments to the contrary are unavailing because they go to the merits of the underlying dispute. Importantly, the merits are not at issue in adjudicating a Motion to Dismiss for failure to state a claim. The only issue for the Board to determine at this time is whether Opposer has stated a proper claim for relief. As set forth below, the TBMP and the governing case law make clear that Opposer’s claim is proper. Hence, the case should move forward without further delay.

¹ Applicant served its Motion to Dismiss by First-Class Mail, so Opposer is permitted twenty (20) days to respond under 37 C.F.R. 2.119(c).

FACTUAL BACKGROUND

The allegations of the Amended Notice of Opposition state as follows:

Opposer is a corporation that owns broad rights to the PAN AM trademark internationally, including in Europe, Asia, South America, Canada and Mexico. (Am. Not. Opp. ¶ 1). Applicant filed U.S. Trademark Application Serial No. 77/931,658 for the mark PAN AM & Design for use in connection with services in Int'l Class 39 on February 12, 2010. (Id. ¶ 2). Opposer filed an application for the mark PAN AM & Design for use in connection with services in Int'l Class 39 on February 19, 2010. (Id. ¶ 3). Opposer's application was rejected pursuant to Section 2(d) of the Lanham Act by virtue of Applicant's application for PAN AM & Design. (Id. ¶ 3).

Applicant does not exist as a legal entity. (Id. ¶ 4). Applicant's counsel has confirmed this fact in submissions to the Board. (Id. ¶ 4). Applicant claims that Application Serial No. 77/931,658 was filed in error and should have been filed in the name of another corporation. (Id. ¶ 5).

Opposer stated as its sole ground for relief that "Applicant is not (and was not at the time of the filing of the instant application), the rightful owner of the instant application, and no valid grounds exist for amending the application. As a result, the application should be declared void ab initio." (Id. ¶ 9).

PROCEDURAL HISTORY

Opposer commenced this proceeding by filing the original Notice of Opposition on October 20, 2010. On November 24, 2010, Applicant filed a Motion to Amend the Application, and on December 22, 2010, Applicant filed a Motion to Stay the Proceedings pending the

Board's ruling on the Motion to Amend. Opposer filed a brief in opposition to Applicant's Motion to Amend on December 14, 2010, and consented to Applicant's Motion to Stay.

On December 27, 2011, the Board issued a ruling deferring further consideration of Applicant's Motion to Stay until a final decision on the merits. By that same order, the Board also, sua sponte, examined the nature and sufficiency of the allegations in the Notice of Opposition related to fraud and deceptiveness, and found them to be lacking. As a result, the Board dismissed the Notice of Opposition, but gave Opposer time to file an amended pleading.

ARGUMENT

1. The Legal Standard for a Motion to Dismiss for Failure to State a Claim is Decidedly in Opposer's Favor

It is well settled that, in adjudicating a motion to dismiss for failure to state a claim, the pleading is to be afforded a liberal construction, all facts alleged are accepted as true, the non-movant is given the benefit of every possible inference, and the test is whether Opposer has stated a claim for relief. Indeed, according to the TBMP:

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. In order to withstand such a motion, a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain such a proceeding, and (2) a valid ground exists for denying the registration sought To survive a motion to dismiss, a complaint "must "state a claim to relief that is plausible on its face."

Therefore, a plaintiff served with a motion to dismiss for failure to state a claim upon which relief can be granted need not, and should not respond by submitting proofs in support of its complaint. Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at a final hearing ... after the parties have had an opportunity to submit evidence in support of their respective positions.

*****'

Whenever the sufficiency of any complaint has been challenged by a motion to dismiss, it is the duty of the Board to examine the complaint in its entirety, construing the allegations therein so as to do justice ... to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought.

TBMP ¶ 503.02 (citing cases).² Here, Opposer can satisfy both the requirements of standing and a valid ground for denying the registration sought.

2. Opposer has Standing

According to 15 U.S.C. § 1063(a), “any person who believes that he would be damaged by the registration of a mark ... may ... file an opposition ... stating the grounds therefor” The issue of standing is not in dispute for purposes of this motion. Opposer has alleged that it owns a U.S. Trademark Application that has been rejected pursuant to Section 2(d) of the Lanham Act because of Applicant’s prior pending U.S. Trademark Application for the same mark. (Am. Not. Opp. ¶¶ 2, 3). Hence, Opposer has standing to bring and maintain this proceeding.

3. Opposer Has Alleged a Proper Ground for Relief

In order to state a claim, Opposer must plead a statutory ground for opposition. Section 309.03(c) of the TBMP sets forth a non-exhaustive list of available grounds for opposition, which includes: (7) “that defendant is not (and was not, at the time of the filing of its application for registration), the rightful owner of the registered mark.” This is the same claim (and in fact the very same language), that Opposer has stated in its Amended Notice of Opposition. (Am. Not. Opp. ¶ 9). In addition, the TBMP section referenced above sets forth a list of Board decisions that authorize this cause of action. (See TBMP § 309.03(c), n. 20). These are the same

² Opposer will submit herewith copies of all cited TBMP sections for the Board’s ease of reference. All cases cited therein are incorporated by reference for purposes of this opposition.

cases that Opposer stated in its Notice of Opposition.³ (Am. Not. Opp. ¶ 8). Because Opposer has alleged sufficient facts to support a valid claim for relief – facts which must be accepted as true for purposes of this motion – Applicant’s motion to dismiss must be denied.

CONCLUSION

For the reasons stated herein, Opposer respectfully requests that the Board deny Applicant’s Motion to Dismiss, and for such other and further relief as the Board deems just and proper.

Dated: February 6, 2012

Respectfully submitted,
Gold Rush Brands, LLC

By: _____/s/
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³ Applicant seeks to distinguish these cases and additional case authority cited in the Amended Notice of Opposition related to Applicant’s right to amend its Trademark Application (see App. Memo of Law at 6-7), but all such arguments relate to the merits of the underlying case and, therefore, are not appropriate for consideration for purposes of this motion to dismiss.

CERTIFICATE OF SERVICE AND FILING

The undersigned certifies that a copy of this Response was served on the Applicant on this 6th day of February, 2012 by sending a copy of the document in an envelope via U.S. mail, First Class, addressed to the Applicant's counsel:

Robert B. Culliford, Esq.
General Counsel
Pan Am Railways
1700 Iron Horse Park
Billerica, MA 01862

and further certifies that the aforementioned papers were filed with the Board on the date indicated above via the Board's on-line computer filing system.

_____/s/_____
Edmund J. Ferdinand, III

**TRADEMARK TRIAL
AND
APPEAL BOARD
MANUAL OF
PROCEDURE
(TBMP)**

Third Edition
May 2011

United States Patent and Trademark Office

**United States Patent and Trademark Office
PREFACE TO THE THIRD EDITION**

The second edition of the Trademark Manual of Board Procedure (“TBMP”) last was revised in 2004. Since then, practice before the Trademark Trial and Appeal Board (“Board”) has significantly changed. This third edition of the TBMP incorporates these many and varied changes in a revised format.

Perhaps the most significant practice development captured in this third edition of the manual is the Board’s adoption of a modified disclosure and conferencing regime for inter partes proceedings commenced on or after November 1, 2007. In an effort to align Board practice more closely with the federal court practice familiar to many who litigate before the Board, all parties to opposition, cancellation and concurrent use proceedings are now obliged to conduct a discovery conference to discuss settlement, narrowing of claims and defenses, and plans for disclosure and discovery. In addition, parties must now make initial, expert testimony, and pretrial disclosures. Revisions reflecting the adoption of the Board’s disclosure and conferencing regime are found throughout this edition, and discussed extensively in Chapters 400 and 700.

Next, this edition of the TBMP highlights the Board’s emphasis on Accelerated Case Resolution (“ACR”), an alternative method of dispute resolution designed to provide parties with a more efficient and less costly method of obtaining a decision on the merits, thus holding the potential for savings in party resources. A detailed discussion of ACR and ACR-type trial efficiencies can be found in Chapters 500 and 700. Where relevant, ACR is also mentioned in other chapters or sections of the TBMP.

Lastly, this updated edition of the TBMP reflects the shift in Board practice from paper to electronic filing and record keeping, and the predominant use of the Board’s electronic filing system (“ESTTA”) and electronic case file system (“TTABVUE”) by practitioners, both of which are accessible at the Board’s web page. Chapter 100 now includes a detailed explanation of ESTTA, and tips for practitioners regarding the use of ESTTA are found throughout the manual.

These are only a few of the developments in Board practice reflected in this latest edition. In addition to many others, practitioners will also find more detailed explanations regarding Madrid Protocol applications in Chapters 200 and 600 as well as concurrent use proceedings (Chapter 1100) and ex parte proceedings (Chapter 1200).

This third edition incorporates all statutory changes, as well as changes to the Trademark Rules of Practice and Federal Rules where applicable as of November 15, 2010. Updated Board and Federal Circuit case citations have been added as

well, to reflect the burgeoning list of precedential orders and decisions issued by the Board since 2006, which now includes close to 300 entries.

In terms of formatting, this edition of the TBMP eliminates the use of footnotes, opting instead for notes at the end of each section or subsection to facilitate ready reference to the associated text. All cross references to the TBMP are now included in the text. For practical ease, the updated version also eliminates the use of “supra” to refer to a previously cited case or authority. All citations to older “TIPS” articles published in the Trademark Reporter have been removed. Practitioners interested in references to these articles may view the second edition of the TBMP, which remains available at the Board home page of the USPTO web site.

In keeping with the Board’s commitment to innovations in electronic government, this edition is available online at the Board home page of the USPTO web site in a searchable format. This edition of the TBMP will facilitate searching of its contents by readers and more frequent and easier updating of the manual by the Board. Given the Board’s continuing commitment to issue a significant number of precedential orders and decisions, and the evolving nature of Board practice, the Board intends to update the TBMP on a frequent basis.

The many Board judges and attorneys who contributed to the thorough updating of the TBMP are deserving of thanks from the Office and user groups who will benefit from this resource. In particular, thanks are extended to Administrative Trademark Judge Carlisle Walters, who developed an initial framework for the revision project, and most of all to Administrative Trademark Judge Angela Lykos, who has labored tirelessly for many months to supervise the work of the participating judges and attorneys. All users of the manual will be well-served by the attention to detail exercised by Judge Lykos.

Gerard Rogers
Chief Administrative Trademark Judge
Trademark Trial and Appeal Board

INTRODUCTION

The purpose of this manual is to provide practitioners with basic information generally useful for litigating cases before the Trademark Trial and Appeal Board. The manual does not modify, amend, or serve as a substitute for any existing statutes, rules, or decisional law and is not binding upon the Board, its reviewing tribunals, the Director, or the USPTO. *Cf., In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989). Rather, the manual describes current practice and procedure under the applicable authority and incorporates amendments to the Trademark Rules of Practice, Trademark Act and Federal Rules, where applicable, as of November 15, 2010. The guidelines set forth in the manual do not have the force and effect of law. They have been developed as a matter of internal office management and are not intended to create any right or benefit, substantive or procedural, enforceable by any party against the office.

The manual is devoted primarily to opposition and cancellation proceedings, the two most common types of inter partes proceedings before the Board. Nonetheless, the manual includes a chapter of general information useful for all proceedings and chapters on interference proceedings, concurrent use proceedings, and ex parte appeals to the Board.

The manual will be updated periodically.

The Board welcomes suggestions for improving the content of the manual. Suggestions and comments should be addressed as follows:

TBMPcomments@uspto.gov, or

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
ATTENTION: TBMP editor

The title of the manual is abbreviated as "TBMP". A citation to a section of the manual may be written as "TBMP § ____" (e.g. "TBMP § 110.01," "TBMP § 113.06," etc.).

CHAPTER 300 PLEADINGS

301 TYPES OF BOARD PROCEEDINGS

- 301.01 IN GENERAL
- 301.02 MARK ON SUPPLEMENTAL REGISTER NOT SUBJECT TO OPPOSITION
- 301.03 MARK FILED UNDER THE MADRID PROTOCOL IS SUBJECT TO
OPPOSITION

302 COMMENCEMENT OF PROCEEDING

303 WHO MAY OPPOSE OR PETITION TO CANCEL

- 303.01 IN GENERAL
- 303.02 MEANING OF THE TERM "PERSON"
- 303.03 MEANING OF THE TERM "DAMAGE"
- 303.04 FEDERAL TRADE COMMISSION
- 303.05 OPPOSITION FILED DURING EXTENSION OF TIME TO OPPOSE
 - 303.05(a) General Rule*
 - 303.05(b) Opposition Filed by Privy*
 - 303.05(c) Misidentification of Opposer*
 - 303.05(d) Misidentification of Applicant or Respondent*
- 303.06 JOINT OPPOSERS OR PETITIONERS

304 PROCEEDING AGAINST MULTIPLE CLASS APPLICATION OR REGISTRATION

305 CONSOLIDATED AND COMBINED COMPLAINTS

- 305.01 CONSOLIDATED COMPLAINT
- 305.02 COMBINED COMPLAINT

306 TIME FOR FILING OPPOSITION

- 306.01 IN GENERAL
- 306.02 DATE OF PUBLICATION OF MARK
- 306.03 PREMATURE OPPOSITION
- 306.04 LATE OPPOSITION

307 TIME FOR FILING PETITION TO CANCEL

- 307.01 PETITION THAT MAY BE FILED AT ANY TIME AFTER REGISTRATION
- 307.02 PETITION THAT MUST BE FILED WITHIN FIVE YEARS FROM THE DATE
OF REGISTRATION
 - 307.02(a) In General*
 - 307.02(b) Trademark Act § 14, 15 U.S.C. § 1064, Limitation is Independent of
Trademark Act § 15, 15 U.S.C. § 1065, Affidavit*
 - 307.02(c) Factors Affecting the Five-Year Period*
 - 307.02(c)(1) Reliance on Registration by Plaintiff*

- 307.02(c)(2) Amendment of Registration
- 307.03 PREMATURE PETITION TO CANCEL
- 307.04 LATE PETITION TO CANCEL

308 FILING FEES

- 308.01 FEE FOR FILING OPPOSITION
 - 308.01(a) *In General*
 - 308.01(b) *Insufficient Fee*
- 308.02 FEE FOR FILING PETITION TO CANCEL
 - 308.02(a) *In General*
 - 308.02(b) *Insufficient Fee*
 - 308.02(c) *Petition Filed by Federal Trade Commission*
 - 308.02(d) *Fee for Counterclaim*
- 308.03 FEES FOR JOINT OPPOSERS OR PETITIONERS
- 308.04 FEES FOR PROCEEDING AGAINST MULTIPLE CLASS APPLICATION OR REGISTRATION
- 308.05 FEES FOR CONSOLIDATED AND COMBINED COMPLAINTS

309 FORM AND CONTENT OF OPPOSITIONS AND PETITIONS TO CANCEL

- 309.01 IN GENERAL
- 309.02 FORM OF COMPLAINT
 - 309.02(a) *Format for Complaint*
 - 309.02(b) *Signature of Complaint*
 - 309.02(c) *Service of Complaint*
 - 309.02(c)(1) Service of Opposition on Applicant
 - 309.02(c)(2) Service of Petition on Respondent
- 309.03 SUBSTANCE OF COMPLAINT
 - 309.03(a) *In General*
 - 309.03(a)(1) Scope of Opposition and Petition to Cancel
 - 309.03(a)(2) Elements of Complaint – In General
 - 309.03(b) *Standing*
 - 309.03(c) *Grounds*
 - 309.03(d) *Remedy Under Trademark Act § 18, 15 U.S.C. § 1068, (Partial Opposition or Partial Cancellation)*
- 309.04 DEFECTS IN COMPLAINT THAT MAY AFFECT INSTITUTION OF PROCEEDING

310 NOTIFICATION TO PARTIES OF PROCEEDING AND SETTING TIME TO ANSWER

- 310.01 NOTIFICATION TO PARTIES OF PROCEEDING
- 310.02 DEFENDANT'S COPY OF NOTIFICATION RETURNED AS UNDELIVERABLE
- 310.03 SETTING TIME FOR FILING ANSWER
 - 310.03(a) *In General*
 - 310.03(b) *5-Day Addition Not Applicable to Deadlines Set by Board*
 - 310.03(c) *Extension of Time to File Answer*

311 FORM AND CONTENT OF ANSWER

311.01 FORM OF ANSWER

311.01(a) Format for Answer

311.01(b) Signature of Answer

311.01(c) Filing and Service of Answer

311.02 SUBSTANCE OF ANSWER

311.02(a) Admissions and Denials

311.02(b) Affirmative Defenses

311.02(c) Unpleaded Affirmative Defenses

311.02(d) Other Affirmative Pleadings - Amplifying Denials

311.03 REPLY TO ANSWER SHOULD NOT BE FILED

312 DEFAULT

312.01 IN GENERAL

312.02 SETTING ASIDE NOTICE OF DEFAULT

312.03 SETTING ASIDE DEFAULT JUDGMENT

313 COUNTERCLAIMS

313.01 IN GENERAL

313.02 FEE FOR COUNTERCLAIM

313.03 FORM AND SUBSTANCE OF COUNTERCLAIM; SERVICE OF COUNTERCLAIM

313.04 COMPULSORY COUNTERCLAIMS

313.05 PERMISSIVE COUNTERCLAIMS

313.06 ANSWER TO COUNTERCLAIM

314 UNPLEADED MATTERS

315 AMENDMENT OF PLEADINGS

316 MOTIONS RELATING TO PLEADINGS

317 EXHIBITS TO PLEADINGS

318 FED. R. CIV. P. 11 APPLICABLE

319 AMENDMENT TO ALLEGE USE; STATEMENT OF USE

84 USPQ2d 1235, 1244 n.10 (TTAB 2007) (defense of unclean hands, even if established, does not deprive petitioner of standing).

17. *See Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009), citing *Liberty Trouser Co., Inc. v. Liberty & Co., Ltd.*, 222 USPQ 357, 358 (TTAB 1983) (averments of priority, likelihood of confusion and damage resulting therefrom accepted to show petitioner's standing with respect to pleaded grounds of fraud and abandonment despite unavailability of likelihood of confusion claim under Trademark Act § 2(d), 15 U.S.C. § 1052(d) because registration more than five years old).

309.03(c) Grounds

In addition to standing, a plaintiff must also plead (and later prove) a statutory ground or grounds for opposition or cancellation. [Note 1.] *See* TBMP § 303.06 regarding pleading of grounds by joint plaintiffs. A plaintiff may raise any available statutory ground for opposition or cancellation that negates the defendant's right to registration. [Note 2.] *See* TBMP § 102.01 and cases cited therein. Grounds for petitions to cancel a Principal Register registration that is more than 5 years old are more limited and are specified in Trademark Act § 14(3) and Trademark Act § 14(5), 15 U.S.C. § 1064(3) and 15 U.S.C. § 1064(5). *See* TBMP § 307.01.

In pleading the grounds for opposition or cancellation, citation to a section of the statute, although encouraged and often helpful in clarifying the nature of a set of allegations in a pleading, may not be sufficient to plead a claim under that section or place a defendant on proper notice of the extent of the claim. For example, although the Trademark Act provides that dilution under Trademark Act § 43(c), 15 U.S.C. § 1125 may be asserted as a claim in a Board proceeding, mere reference to that section of the Trademark Act is insufficient to plead a dilution claim, as proper pleading of the claim also requires an allegation that the plaintiff's mark was famous prior to the earliest date on which the defendant can rely for purposes of priority. [Note 3.]

A plaintiff cannot rely upon an unpleaded claim unless the plaintiff's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter. [Note 4.] *See also* TBMP § 314. In cases brought under Trademark Act § 2(d), 15 U.S.C. § 1052(d) the plaintiff must specifically plead any registrations on which it is relying and may not rely at trial on unpleaded registrations. [Note 5.] For information regarding express or implied consent to the trial of an unpleaded issue, *see* TBMP § 507.03(b).

Examples of available grounds for opposition and for cancellation are listed below. **Please Note:** The grounds identified in examples 2 (as to *de jure* functional marks), 3, and 12 through 14 are available for cancellation of a Principal Register registration over five years old. This list is exemplary, not exhaustive.

(1) Trademark Act § 2(d), 15 U.S.C. § 1052(d): That defendant's mark so resembles a mark registered in the Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the defendant, to cause confusion, or to cause mistake, or to deceive. [Note 6.]

(2) Trademark Act § 2(e), 15 U.S.C. § 1052(e): For example, that defendant's mark, when used on or in connection with the goods or services of the defendant, is merely descriptive or deceptively misdescriptive of them, [Note 7] or that defendant's mark is primarily geographically descriptive [Note 8] or primarily geographically deceptively misdescriptive of them [Note 9]; or that defendant's mark is primarily merely a surname [Note 10]; or that defendant's mark comprises any matter that, as a whole, is *de jure* functional; or if not *de jure* functional, that the product design has not acquired distinctiveness. [Note 11.]

(3) Trademark Act § 2(a), 15 U.S.C. § 1052(a): For example, that defendant's mark is geographically deceptive, [Note 12] that defendant's mark disparages members of a particular group, [Note 13] that defendant's mark consists of or comprises immoral, deceptive, or scandalous matter, [Note 14] that defendant's mark falsely suggests a connection with plaintiff's name or identity [Note 15], or that defendant's mark is a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and was first used on or in connection with wines or spirits by the applicant on or after January 1, 1996. [Note 16.]

(4) That there was no bona fide use of defendant's mark in commerce prior to the filing of the use-based application for its registration under Trademark Act § 1(a), 15 U.S.C. § 1051(a). [Note 17.]

(5) That defendant did not have a bona fide intent to use the mark in connection with the identified goods/services as of the filing date of the application under Trademark Act § 1(b), 15 U.S.C. § 1052(b). [Note 18.]

(6) That defendant's mark is a mere background design that does not function as a mark separate and apart from the words displayed thereon. [Note 19.]

(7) That defendant is not (and was not, at the time of the filing of its application for registration) the rightful owner of the registered mark. [Note 20.]

(8) That defendant's mark, consisting of a particular color combination applied to its goods, is ornamental and has not become distinctive as an indication of the source of defendant's goods, [Note 21] or that defendant's mark, consisting of a particular sound applied to its goods, is not inherently distinctive and has not acquired distinctiveness. [Note 22.]

(9) That the term for which registration is sought or for which registration has been obtained has not been used as a trademark or service mark. [Note 23.]

(10) That defendant's mark represents multiple marks in a single application (or registration) ("phantom mark"). [Note 24.]

(11) That defendant's mark has been abandoned due to nonuse with intent not to resume use, and nonuse for three consecutive years shall be prima facie evidence of abandonment, [Note 25]; or due to a course of conduct that has caused the mark to lose significance as an indication of source. [Note 26.]

(12) That defendant's mark consists of or comprises the name of a particular living individual without the individual's consent. [Note 27.]

(13) That defendant's product design is generic. [Note 28.]

(14) That defendant's mark would dilute the distinctive quality of plaintiff's famous mark. [Note 29.]

(15) That defendant has used its mark so as to misrepresent the source of its goods or services. [Note 30.]

(16) That defendant has misused the federal registration symbol with intent to deceive the purchasing public or others in the trade into believing that the mark is registered. [Note 31.]

(17) That defendant committed fraud in the procurement of its registration or during the prosecution of its application for registration. [Note 32.]

(18) That defendant's registered mark interferes with the registration of a foreign owner's mark under Article 8 of the General Inter-American Convention for Trademark and Commercial Protection of Washington, 1929 ("Pan American Convention"), 46 Stat. 2907. [Note 33.]

(19) That defendant's application is barred from registration by claim or issue preclusion. [Note 34.] *See also* TBMP § 311.02(b).

The following is a brief discussion of the elements of a claim of likelihood of confusion, the most frequently encountered issue in Board inter partes proceedings.

Pursuant to Trademark Act § 2(d), 15 U.S.C. § 1052(d), plaintiff must assert, and then prove at trial, that defendant's mark, as applied to its goods or services, so resembles plaintiff's previously used or registered mark or its previously used trade name as to be likely to cause confusion, mistake, or deception.

A. Priority

A plaintiff must plead (and later prove) priority of use. [Note 35.] In order to properly assert priority, a plaintiff must allege facts showing proprietary rights in its pleaded mark that are prior to defendant's rights in the challenged mark. [Note 36.] Such rights may be shown by, for example, ownership of an application with a filing date (or a registration with an underlying application filing date) prior to any date of first use on which defendant can rely; [Note 37] prior trademark or service mark use; [Note 38] or prior use analogous to trademark or service mark use. [Note 39.]

However, priority is not in issue in an opposition where opposer pleads (and later proves) that it owns a registration for its pleaded mark, [Note 40] provided that there is no counterclaim or separate petition to cancel the pleaded registration, or any counterclaim or separate petition to cancel the pleaded registration by the applicant is ultimately dismissed and the registration

remains uncanceled. [Note 41.]

A plaintiff may be permitted to assert the proprietary rights or registration(s) of a third-party as a basis for a Trademark Act § 2(d), 15 U.S.C. § 1052(d) ground if plaintiff can show a legitimate interest in preventing confusion between the pleaded mark(s) and the defendant's mark. [Note 42.]

B. Likelihood of Confusion

The evidentiary factors the Board considers in determining likelihood of confusion are set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). These factors include the similarity of the marks, the relatedness of the goods and/or services, the channels of trade and classes of purchasers for the goods and/or services, the number and nature of similar marks in use on similar goods, the nature and extent of any actual confusion, and the fame of the prior mark. [Note 43.] The relevance and weight to be given the various factors may differ from case to case and a single *du Pont* factor may be dispositive in certain cases. [Note 44.]

Direct or Hypothetical Pleading of Likelihood of Confusion: A plaintiff may plead likelihood of confusion directly or hypothetically. [Note 45.] A hypothetical pleading may consist of assertions that if, as the trademark examining attorney (or the defendant) contends, plaintiff's mark so resembles defendant's mark as to be likely, when applied to the goods and/or services of the plaintiff, to cause confusion, then plaintiff will be damaged by the registration of defendant's mark. [Note 46.] Of course, in order to state a claim upon which relief can be granted, a hypothetical pleading of likelihood of confusion must be coupled with a pleading of one or more grounds for opposition or cancellation, such as, that defendant's mark has been abandoned; that plaintiff has priority of use (here, the hypothetical pleading of likelihood of confusion serves both as a pleading of plaintiff's standing and as part of the pleading of a ground under Trademark Act § 2(d), 15 U.S.C. § 1052(d)); etc. Thus, a plaintiff wishing to plead likelihood of confusion hypothetically in a proceeding based upon Trademark Act § 2(d), 15 U.S.C. § 1052(d) might assert, for example, that if, as the trademark examining attorney (or the defendant) contends, plaintiff's mark so resembles defendant's mark as to be likely, when applied to the goods and/or services of the plaintiff, to cause confusion, then the registration sought by defendant should be refused (or defendant's registration should be cancelled) because plaintiff has priority of use. [Note 47.]

NOTES:

1. See *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998). See also, *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009) (if plaintiff can show standing on one ground, has right to assert any other grounds); *Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d 1393, 1396 n.1 (TTAB 2009) (grounds for opposition not pursued at trial or otherwise argued by opposer in its brief deemed waived).
2. See *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir.

1987), *on remand*, 5 USPQ2d 1622 (TTAB 1987), *rev'd*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *McDermott v. San Francisco Womens Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006), *aff'd unpub'd*, 240 Fed. Appx. 865 (Fed. Cir. 2007), *cert. den'd*, 552 U.S. 1109 (2008) (Board does not have authority to determine whether a party has engaged in criminal or civil wrongdoings); *Flash & Partners S.p.A. v. I.E. Manufacturing LLC*, 95 USPQ2d 1813 (TTAB 2010) (ex parte examination issues do not form a basis for cancellation); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1586 (TTAB 2008); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008) (parties' agreement prohibits applicant's use of its mark); *Carano v. Vina Concha y Toro S.A.*, 67 USPQ2d 1149, 1152 (TTAB 2003) (Board has no jurisdiction to determine copyright infringement claim but may determine some limited copyright issues as necessary to determine questions of trademark registration); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1034 n.3 (TTAB 1996) (Board lacks authority to determine claim that Congress may not lawfully regulate registrant's activities); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1386 (TTAB 1991); *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843, 1844 (TTAB 1989); and *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909, 910 n.10 (TTAB 1984) (Board cannot decline to consider an issue because it is ex parte in nature). *Cf. Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998) ("economic damage" is not a ground for opposition although it is relevant to issue of opposer's standing); *Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587 (TTAB 2009) (Paris Convention does not provide independent cause of action); *Franpovi SA v. Wessin*, 89 USPQ2d 1637 (TTAB 2009) (potential plaintiff cannot exercise rights established by Santiago Convention because it cannot fulfill condition of application to the Inter American Bureau as set forth in Convention); *Demon International LC v. Lynch*, 86 USPQ2d 1058 (TTAB 2008) (asserted error by examining attorney is not a proper ground for opposition); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1884 n.3 (TTAB 2006) (Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPs") does not provide separate cause of action or defense); *Saint-Gobain Abrasives Inc. v. Unova Industrial Automation Systems Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003) (whether description of the mark is adequate is an examination issue and fails to state a proper ground for opposition); *Seculus Da Amazonia S/A v. Toyota Jidosha Kabushiki Kaisha*, 66 USPQ2d 1154 (TTAB 2003) (no authority for assertion of unclean hands as a ground for opposition); *Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702 (TTAB 2002) (laches and acquiescence are affirmative defenses, not grounds for opposition); *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057 (TTAB 2000) (opposer's failure to submit copy of the foreign registration, which was the basis for issuance of opposer's pleaded registration, was an examination error and did not constitute a ground for counterclaim); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1401 n.39 (TTAB 1994) (equitable defenses are not grounds for opposition); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1358 (TTAB 1989) (the insufficiency of the specimens, per se, does not constitute grounds for cancellation; the proper ground for cancellation is that the term has not been used as a mark); and *Century 21 Real Estate Corp. v. Century Life of America*, 11 USPQ2d 1355, 2035 (TTAB 1989) ("it is not the adequacy of the specimens, but the underlying question of service mark usage which would constitute a proper ground for opposition").

3. See Trademark Act § 43(c), 15 U.S.C. § 1125(c); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1649 (TTAB 2010) (party alleging fame must show that mark became famous before applicant's use of challenged mark); *Demon International LC v. Lynch*, 86 USPQ2d 1058, 1059-1060 (TTAB 2008) (dilution claim in pleading must include an allegation that opposer's mark at issue is famous); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001) (dilution pleading legally insufficient where opposer failed to allege that its mark became famous before constructive use date of involved intent-to-use application); *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1174 n.9 (TTAB 2001); and *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000).

4. See *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.3 (TTAB 2009); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103 n.3 (TTAB 2007).

5. See, e.g., *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1503 (TTAB 2007) ("In its brief, opposer listed a seventh registration, but it was not pleaded and a copy was not made of record by notice of reliance (NOR) or through testimony, so it has not been considered"); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1919-20 (TTAB 2006). Cf. *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1583, n.3 (TTAB 2008) ("The notice of reliance also includes status and title copies of several registrations which were not pleaded in the notice of opposition. Because applicant has not objected to opposer's reliance on the unpleaded registrations, and moreover has, in effect, treated them as of record in his brief, we deem opposer's pleading amended to assert the registrations under Fed. R. Civ. P. 15(b)").

6. See, e.g., *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992); and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002). See also *First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 476 F.3d 867, 81 USPQ2d 1375, 1378 (Fed. Cir. 2007) (claim of prior intrastate use); *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1756 (TTAB 2009) (doctrine of foreign equivalents inapplicable but likelihood of confusion found); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1023 (TTAB 2009) (earliest date respondent may rely upon is the filing date of its underlying application in absence of evidence of earlier use; petitioner must show earlier common law use in absence of registration); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) (dissimilarity of marks controlling issue in likelihood of confusion analysis); *Apple Computer v. TVNET.net Inc.*, 90 USPQ2d 1393 (TTAB 2007); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008) (although opposer failed to make its registrations of record, its burden is to demonstrate that it owns a trademark, which was used prior to applicant's mark, and not abandoned); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007) (family of marks); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007) (determination of likelihood of confusion based on an analysis of all facts in evidence); *Christian Broadcasting Network Inc. v. ABS-CBN International*, 84 USPQ2d 1560, 1565 (TTAB 2007)

(several factors considered); *Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624 (TTAB 2007) (design marks compared); *Miss Universe L.P., v. Community Marketing, Inc.*, 82 USPQ2d 1562 (TTAB 2007) (“Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors)”); and *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1113 (TTAB 2007) (doubt resolved in favor of prior user).

7. See Trademark Act § 2(e)(1), 15 U.S.C. § 1052(e)(1). See also, e.g., *The Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720 (Fed. Cir. 2001) (deceptive misdescriptiveness) and *Callaway Vineyard & Winery v. Endsley Capital Group, Inc.*, 63 USPQ2d 1919 (TTAB 2002) (mere descriptiveness). Regarding claims under Trademark Act § 2(f), 15 U.S.C. § 1052(f), see *Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (in cancellation proceeding, presumption of validity of registration under Trademark Act § 2(f) includes presumption of acquired distinctiveness, and party seeking cancellation must overcome this presumption by preponderance of evidence; “burden” to prove that mark has acquired distinctiveness shifts to registrant only after plaintiff establishes prima facie case that mark has not acquired distinctiveness); *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (in opposing a claim under Trademark Act § 2(f), opposer has initial burden of challenging or rebutting applicant’s evidence of distinctiveness); *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1680 (TTAB 2007) (ultimate burden of persuasion under Trademark Act § 2(f) rests with applicant); and *Kellogg Co. v. General Mills Inc.*, 82 USPQ2d 1766, 1768 (TTAB 2007) (mere descriptiveness; whether claim under Trademark Act § 2(f) is sufficient).

8. See Trademark Act § 2(e)(2), 15 U.S.C. § 1052(e)(2). See also, e.g., *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1504 (TTAB 2008) (whether mark is descriptive and/or primarily geographically descriptive, applicant has shown acquired distinctiveness); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994).

9. See Trademark Act § 2(e)(3), 15 U.S.C. § 1052(e)(3). See also *In re California Innovations, Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003) (the test for determining whether a mark is geographically deceptive under Trademark Act § 2(a), 15 U.S.C. § 1052(a) is the same as determining whether a mark is primarily geographically deceptively misdescriptive under Trademark Act § 2(e)(3), 15 U.S.C. § 1052(e)(3)); *In re Save Venice New York, Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001); *Corporacion Habanos S.A. v. Annecas Inc.*, 88 USPQ2d 1785 (TTAB 2008) (primarily geographically deceptively misdescriptive and deceptive claims); *United States Playing Card Co., v. Harbro, LLC*, 81 USPQ2d 1537 (TTAB 2006) (addressing deceptiveness of a geographic term); and *In re Wada*, 48 USPQ2d 1689 (TTAB 1998), *aff’d*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999).

10. See Trademark Act § 2(e)(4), 15 U.S.C. § 1052(e)(4). See also, e.g., *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132 (TTAB 2000); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 391-92 (TTAB 1979); and *Food Specialty Co. v. Carnation Co.*, 170 USPQ

522, 523 (TTAB 1971). *Cf. In re Rath*, 402 F.3d 1207, 74 USPQ2d 1174 (Fed. Cir. 2005); and *In re Piano Factory Group Inc.*, 85 USPQ2d 1522 (TTAB 2007).

11. See Trademark Act § 2(e)(5), 15 U.S.C. § 1052(e)(5); *TrafFix Devices Inc. v. Marketing Displays Inc.*, 523 U.S. 23, 58 USPQ2d 1001, 1006 (2001); and *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161 (1995). See also, e.g., *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, (TTAB 2009) (product configuration); and *M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001). *Cf. Duramax Marine, LLC v. R.W. Fernstrum & Company*, 80 USPQ2d 1780 (TTAB 2006) (prohibition on the registration of functional marks does not extend to registration of two-dimensional design mark for custom manufacturing services).

12. See, e.g., *Consorzio del Prosciutto di Parma v. Parma Sausage Products, Inc.*, 23 USPQ2d 1894 (TTAB 1992) (mark's geographic deceptiveness must be established as of the time the registration issues). *Cf. Corporacion Habanos S.A. v. Amncas Inc.*, 88 USPQ2d 1785 (TTAB 2008) (Board declines to consider geographically deceptive claim under Trademark Act § 2(a), 15 U.S.C. § 1052(a)); *United States Playing Card Co., v. Harbro, LLC*, 81 USPQ2d 1537 (TTAB 2006) (addressing deceptiveness of a geographic term under the ambit of Trademark Act § 2(e)(3), 15 U.S.C. § 1052(e)(3) rather than Trademark Act § 2(a), 15 U.S.C. § 1052(a), citing *In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853, 1856 (Fed. Cir. 2003) ("The amended Lanham Act gives geographically deceptively misdescriptive marks the same treatment as geographically deceptive marks under § 1052(a)."); *K-Swiss Inc. v. Swiss Army Brands Inc.*, 58 USPQ2d 1540, 1543 (TTAB 2001) (can be cancelled if a registrant, through its own actions, causes its mark to become geographically deceptive subsequent to the issuance of the registration).

13. See, e.g., *In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010) (religious affiliation); *In re Heeb Media, LLC*, 89 USPQ2d 1071 (TTAB 2008) (religious affiliation); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) (disparagement); *In re Squaw Valley Development Co.*, 80 USPQ2d 1264 (TTAB 2006) (disparagement); *McDermott v. San Francisco Womens Motorcycle Contingent*, 81 USPQ2d 1212 (TTAB 2006); *aff'd unpub'd*, 240 Fed.Appx. 865 (Fed. Cir. 2007), *cert. denied*, 552 U.S. 1109 (2008) (while individual male citizen sufficiently alleged a "real interest" in the proceedings, he failed to properly allege "belief of damage," as he does not inherently possess an immutable trait directly implicated by the mark or allege that others share his belief of damage); *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600 (TTAB 1999) (women in general and African American women in particular); *Order Sons of Italy in America v. Memphis Mafia Inc.*, 52 USPQ2d 1364 (TTAB 1999) (members of plaintiff's Order and Italian-Americans in general); and *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1740-48 (TTAB 1999), *rev'd*, 284 F. Supp. 2d 96, 125, 68 USPQ2d 1225, 1248 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), and *aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009) (cancellation action brought by Native Americans on grounds of disparagement barred by laches).

14. See, e.g., *Corporacion Habanos S.A. v. Amncas Inc.*, 88 USPQ2d 1785 (TTAB 2008)

(deceptiveness); *Boston Red Sox Baseball Club Limited Partnership v. Sherman*, 88 USPQ2d 1581, 1588 (TTAB 2008); *In re Boulevard Entertainment, Inc.*, 334 F.3d 1336, 67 USPQ2d 1475 (Fed. Cir. 2003) (use of dictionary evidence to determine whether mark is scandalous); and *In re Mavety Media Group, Ltd.*, 33 F.3d 1367, 31 USPQ2d 1923 (Fed. Cir. 1994) (analyzing mark in terms of “vulgarity”). See also *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) (standing to oppose on Trademark Act § 2(a), 15 U.S.C. § 1052(a) grounds); *In re South Park Cigar, Inc.*, 82 USPQ2d 1507 (TTAB 2007) (deception involving geographical mark); *In re Red Bull GmbH*, 78 USPQ2d 1375 (TTAB 2006) (scandalous mark); *In re Wilcher Corp.*, 40 USPQ2d 1929 (TTAB 1996) (design mark scandalous); and *In re Old Glory Condom Corp.*, 26 USPQ2d 1216, 1220 (TTAB 1993) (design mark not scandalous). Cf. *McDermott v. San Francisco Womens Motorcycle Contingent*, 81 USPQ2d 1212, 1214 (TTAB 2006), *aff'd unpub'd*, 240 Fed.Appx. 865 (Fed. Cir. 2007), *cert. denied*, 552 U.S. 1109 (2008) (authority of Trademark Act § 2(a), 15 U.S.C. § 1052(a) does not extend to goods or services that may be viewed as scandalous or immoral in nature).

15. See, e.g., *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co. Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *Boston Red Sox Baseball Club Limited Partnership v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435 (TTAB 1996); *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635 (TTAB 1988); and *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985).

16. See *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (certification mark recognized as a geographical indication). Cf. *In re Spirits International N.V.*, 86 USPQ2d 1078, 1080 n.2 (TTAB 2008) (refusal based on “deceptiveness” provision of Trademark Act § 2(a), 15 U.S.C. § 1052(a) and not that the mark is a geographical indication); and *In re Wada*, 48 USPQ2d 1689, 1692 n.7 (TTAB 1998) (disclaimer of geographical indication cannot obviate a Trademark Act § 2(a), 15 U.S.C. § 1052(a) refusal).

17. See, e.g., *International Mobile Machines Corp. v. International Telephone and Telegraph Corp.*, 800 F.2d 1118, 231 USPQ 142 (Fed. Cir. 1986); *Avakoff v. Southern Pacific Co.*, 765 F.2d 1097, 226 USPQ 435 (Fed. Cir. 1985); *Paramount Pictures Corp. v. White*, 31 USPQ 1768 (TTAB 1994) (“use in commerce” involves the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark), *aff'd unpub'd*, 108 F.3d 1392 (Fed. Cir. 1997); *Nutrasweet Company v. K & S Foods Inc.*, 4 USPQ2d 1964 (TTAB 1987); *Pennwalt Corp. v. Sentry Chemical Co.*, 219 USPQ 542, 558 (TTAB 1983); and *Bonaventure Associates v. Westin Hotel Co.*, 218 USPQ 537, 543 (TTAB 1983). Cf. *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1033 (TTAB 2007) (opposer’s nonuse claim dismissed as moot upon Board’s acceptance of applicant’s amendment of the filing basis of its application from Trademark Act § 1(a) to 1(b), 15 U.S.C. § 1051(a) to (b)); and *CarX Service Systems, Inc. v. Exxon Corp.*, 215 USPQ 345, 351 (TTAB 1982) (plaintiff must plead and prove that there was no use prior to filing date; mere claim that dates of use are incorrect does not state a claim of action).

18. See, e.g., *Honda Motor Co., Ltd. v. Friedrich Winkelmann*, 90 USPQ2d 1660 (TTAB 2009) (lack of bona fide intent to use); *Boston Red Sox Baseball Club LP v. Sherman*, 88

USPQ2d 1581, 1587 (TTAB 2008) (lack of bona fide intent to use); *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1352 (TTAB 1994); and *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1504 (TTAB 1993). *Cf. Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1643 (TTAB 2007) (capacity to market and /or manufacture goods, having produced them in the past under different marks, rebuts claim that applicant lacked bona fide intent to use).

19. *See, e.g., In re Grande Cheese Co.*, 2 USPQ2d 1447 (TTAB 1986); *General Foods Corp. v. Ito Yokado Co., Ltd.*, 219 USPQ 822, 825 (TTAB 1983), *aff'd unpub'd*, slip. op. 84-517 (Fed. Cir. 1984).

20. *See, e.g., Ballet Tech Foundation, Inc. v. The Joyce Theater Foundation, Inc.*, 89 USPQ2d 1262 (TTAB 2008); *Anheuser-Busch Inc. v. The Florists Association of Greater Cleveland Inc.*, 29 USPQ2d 1146 (TTAB 1993); *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318, 1320 (TTAB 1990); and *Kemin Industries, Inc. v. Watkins Products, Inc.*, 192 USPQ 327, 328 (TTAB 1976). *Cf. e.g., Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993) *recon. den.*, 36 USPQ2d 1328 (TTAB 1994) (where opposer was asserting that applicant's mark is a descriptive term which cannot be owned exclusively by anyone, rather than alleging that someone other than applicant is the owner of the term as a mark).

21. *See, e.g., Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995); *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 86 USPQ2d 1369 (Fed. Cir. 2008); *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir.1994), *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, (Fed. Cir.1985); *Goodyear Tire & Rubber Co. v. Vogue Tyre & Rubber Co.*, 47 USPQ2d 1748 (TTAB 1998); and *Kassnar Imports v. Plastilite Corp.*, 180 USPQ 156, 157 (TTAB 1973), *aff'd*, 508 F.2d 824, 184 USPQ 348, 350 (CCPA 1975).

22. *See Trademark Act § 1, Trademark Act § 2 and Trademark Act § 45, 15 U.S.C. § 1051, 15 U.S.C. § 1052 and 15 U.S.C. § 1127; Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d 1393 (TTAB 2009) (“chirp” sound). *Cf. In re Vertex Group LLC*, 89 USPQ2d 1694, 1700 (TTAB 2009) (registration on the Principal Register of the sound emitted by applicant's product in its normal course of operation only available on a showing of acquired distinctiveness).

23. *See, e.g., Aycock Engineering, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1309 n.12 (Fed. Cir. 2009) (registration on Supplemental Register never becomes immune from threat of invalidation on grounds that mark was not used prior to filing date); *Anheuser-Busch Inc. v. The Florists Association of Greater Cleveland, Inc.*, 29 USPQ2d 1146, 1160 (TTAB 1993) (allegation that slogan was used as mere advertising and not as a trademark); and *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355 (TTAB 1989).

24. *See, e.g., Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres*, 56 USPQ2d 1538 (TTAB 2000). *See also In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812-1813 (Fed. Cir. 2001); *In re International Flavors & Fragrances Inc.*, 47 USPQ2d 1314 (TTAB 1998), *aff'd*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999).

25. Trademark Act § 45, 15 U.S.C. § 1127. See, e.g., *Linville v. Rivard*, 41 USPQ2d 1731 (TTAB 1996), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); and *Auburn Farms, Inc. v. McKee Foods Corp.*, 51 USPQ2d 1439 (TTAB 1998). Cf. *General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179 (TTAB 2008) (plaintiff could not prove priority because it abandoned mark with no intent to resume use prior to use by defendant); and *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007) (plaintiff must allege ultimate facts pertaining to the alleged abandonment).
26. Trademark Act § 45, 15 U.S.C. § 1127. See, e.g., *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, (TTAB 2009) (failure to police third party use of marks); *Ballet Tech Foundation, Inc. v. The Joyce Theater Foundation, Inc.*, 89 USPQ2d 1262 (TTAB 2008) (use of marks pursuant to implied license inures to benefit of licensor); *Tea Board of India v. The Republic of Tea, Inc.* 80 USPQ2d 1881 (TTAB 2006); and *Woodstock's Enterprises Inc. v. Woodstock's Enterprises Inc.*, 43 USPQ2d 1440 (TTAB 1997), *aff'd*, 152 F.3d 942 (Fed. Cir. Mar. 5, 1998).
27. See Trademark Act § 2(c), 15 U.S.C. § 1052(c). See also *Chester L. Krause v. Krause Publications, Inc.*, 76 USPQ2d 1904 (TTAB 2005), *aff'd* slip. op. 2007-1364 (Fed. Cir. Dec. 7, 2007); *Ross v. Analytical Technology, Inc.*, 51 USPQ2d 1269 (TTAB 1999) (plaintiff must establish that the “name,” as used on the goods or services, points uniquely to plaintiff as a “particular living individual”); and *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994) (party asserting Trademark Act § 2(c), 15 U.S.C. § 1052(c) ground must have cognizable or proprietary right in the name). Cf. *Societe Civile Des Domaines Dourthe Freres v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205 (TTAB 1988) (Trademark Act § 2(c), 15 U.S.C. § 1052(c) does not apply to family surnames).
28. See *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, (TTAB 2009); *Sunrise Jewelry Manufacturing Corp. v. Fred, S.A.*, 175 F.3d 1322, 50 USPQ2d 1532 (Fed. Cir. 1999) (the term “generic name” as used in Trademark Act § 14(3), 15 U.S.C. § 1064(3) includes trade dress such as product design or configuration).
29. See Trademark Act § 13(a) and Trademark Act § 14, 15 U.S.C. § 1063(a) and 15 U.S.C. § 1064; *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001). See also Trademark Act § 43(c), 15 U.S.C. § 1125(c); *National Pork Board and National Pork Producers Council v. Supreme Lobster and Seafood Company*, 96 USPQ2d 1479 (TTAB 2010) (commodity promotion slogan dilution by blurring); *Coach Services, Inc. v. Triumph Learning LLC*; 96 USPQ2d 1479 (TTAB 2010) (dilution by blurring and tarnishment); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1649 (TTAB 2010) (party alleging fame must show that mark became famous before applicant’s use of challenged mark); *Demon International LC v. Lynch*, 86 USPQ2d 1058, 1059-1060 (TTAB 2008) (dilution claim in pleading must include an allegation that opposer’s mark at issue is famous); *Moseley v. V Secret Catalogue Inc.*, 537 US 418, 65 USPQ2d 1801 (2003); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001) (dilution pleading legally insufficient where opposer failed to allege that its mark became famous before constructive use date of involved intent-to-use application); *Toro*

Co. v. ToroHead, Inc., 61 USPQ2d 1164, 1174 n.9 (TTAB 2001); and *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000); and, e.g., *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car, Inc.*, 62 USPQ2d 1857 (TTAB 2002), *aff'd*, 300 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003). *But see Fiat Group Automobiles, S.p.A. v. ISM, Inc.*, 94 USPQ2d 1111 (TTAB 2010) (the “well known mark” doctrine does not constitute a basis for pleading dilution in the United States, absent a specific pleading of intent to use, the filing of an application for registration, and some basis for concluding that recognition of the mark in the United States is sufficiently widespread as to create an association of the mark with particular products or services, even if the source thereof is anonymous and even if the products or services are not available in the United States).

30. *See Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587 (TTAB 2009) (motion to dismiss misrepresentation of source claim denied); *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007) (pleading of misrepresentation of source must be supported by allegations of blatant misuse of the mark by respondent in a manner calculated to trade on the goodwill and reputation of petitioner); and *The E.E. Dickinson Co. v. The T.N. Dickinson Company*, 221 USPQ 713 (TTAB 1984) (petitioner allowed to go forward on claim of misrepresentation of source).

31. *See Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752 (TTAB 2009) (mistaken belief that registration of mark in foreign country permits use of symbol); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1290 (TTAB 2007) (allegation that opposer has misused federal registration symbol construed “as a species of the equitable affirmative defense of unclean hands”); *Johnson Controls, Inc. v. Concorde Battery Corp.*, 228 USPQ 39, 44 (TTAB 1985); and *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844 n.3 (TTAB 2008). *Cf. Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 27 (CCPA 1976) (raised as affirmative defense).

32. *See Fed. R. Civ. P. 9(b)*; *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009); *DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086 (TTAB 2010) (summary judgment on fraud claim denied); *Enbridge, Inc. v. Excelerate Energy Limited Partnership*, 92 USPQ2d 1537 (TTAB 2009). *See also Exergen Corp. v. Wal-Mart Stores Inc.*, 575 F.3d 1312, 91 USPQ2d 1656, 1670 (Fed. Cir. 2009), *citing Kowal v. MCI Communications Corp.*, 16 F.3d 1271, 1279 n.3 (D.C. Cir. 1994) (“[P]leadings on information and belief require an allegation that the necessary information lies within the defendant's control, and ... such allegations must also be accompanied by a statement of the facts upon which the allegations are based”); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986); *King Auto., Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 803 (CCPA 1981) (fraud must be pleaded with particularity); *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981) (fraud requires a willful intent to deceive); *G&W Laboratories Inc. v. GW Pharma Ltd.*, 89 USPQ2d 1571, 1574 (TTAB 2009) (a finding of fraud as to one class in a multiple-class registration does not require cancellation of all classes in a registration); *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1509 (TTAB 2008) (false claim of use of mark); and *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (TTAB 2006) (same). *Cf. Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478

Board will not only reset the time for the defendant to answer but will also reset the discovery conference deadline and other appropriate dates or deadlines. [Note 4.]

The defense of failure to state a claim upon which relief can be granted may be raised after an answer is filed, provided that it is raised by some means other than a motion to dismiss. For example, the defense may be raised, after an answer is filed, by a motion for judgment on the pleadings, by a motion for summary judgment, or at trial. [Note 5.]

NOTES:

1. Fed. R. Civ. P. 12(b); *Hollowform Inc. v. Delma Aeh*, 180 USPQ 284, 285 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975). Compare *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 n.1 (TTAB 1998) (although a Fed. R. Civ. P. 12(b)(6) motion should be filed prior to, or concurrently with the answer, untimeliness waived where Fed. R. Civ. P. 12(b)(6) motion filed three weeks after answer, but plaintiff responded to motion on the merits).
2. *William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870, 1872 (TTAB 1994) (“Just as a motion to dismiss can be interposed in response to an original pleading, so too can it be interposed in response to an amended pleading”).
3. *Hollowform, Inc. v. Delma Aeh*, 180 USPQ 284, 286 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975) (motion for default judgment for failure to answer denied).
4. Cf. 37 CFR § 2.120(a)(2) and 37 CFR § 2.127(d). See also Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007) (“Because disclosure is tied to claims and defenses, in general, a defendant’s default or the filing of various pleading motions under Federal Rule 12 will effectively stay the parties’ obligations to conference and, subsequently, make initial disclosures.”).
5. Fed. R. Civ. P. 12(h)(2); *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1436 (TTAB 1995); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990) (construed as motion for judgment on the pleadings); C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL 3d § 1357 (2009). Compare, *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995) (Fed. R. Civ. P. 12(b)(6) permits defendant to assert in answer “defense” of failure to state a claim thereby allowing plaintiff to test sufficiency of defense by moving under Fed. R. Civ. P. 12(f) to strike the defense).

503.02 Nature of Motion

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. [Note 1.] In order to withstand such a motion, a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought (in the case of an opposition), or for canceling

the subject registration (in the case of a cancellation proceeding). [Note 2.] To survive a motion to dismiss, a complaint must “state a claim to relief that is plausible on its face.” [Note 3.]

Therefore, a plaintiff served with a motion to dismiss for failure to state a claim upon which relief can be granted need not, and should not respond by submitting proofs in support of its complaint. Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions. [Note 4.]

In Board proceedings, there are certain facts not subject to proof – such as the filing date, filing basis, publication date and applicant’s name in an application that is the subject of an opposition proceeding – that the Board may consider when a party has filed a motion to dismiss under Fed. R. Civ. P. 12(b)(6). [Note 5.]

Whenever the sufficiency of any complaint has been challenged by a motion to dismiss, it is the duty of the Board to examine the complaint in its entirety, construing the allegations therein so as to do justice, as required by Fed. R. Civ. P. 8(e), to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought. [Note 6.]

For a further discussion regarding the elements of a complaint, see TBMP § 309.03(a)(2).

NOTES:

1. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Bayer Consumer Care Ag v. Belmora LLC*, 90 USPQ2d 1587, 1590 (TTAB 2009), quoting, *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1218 (TTAB 1990); and *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 753 (TTAB 1985).
2. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Bayer Consumer Care Ag v. Belmora LLC*, 90 USPQ2d 1587, 1590 (TTAB 2009); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theaters*, 56 USPQ2d 1538, 1539 (TTAB 2000); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1462 (TTAB 1992); *Hartwell Co. v. Shane*, 17 USPQ2d 1569, 1570 (TTAB 1990); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 753 (TTAB 1985); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156 (TTAB 1985); and *Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S.*, 222 USPQ 512, 514 (TTAB 1984).
3. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007) (retiring the pleading standard set forth in *Conley v. Gibson*, 355 U.S. 41 (1957) that dismissal for failure to state a claim is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim). See also *Ashcroft v. Iqbal*, 556 U.S.--, 129 S.Ct. 1937 (2009) (plausibility standard applies to all federal civil claims).

4. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

5. *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1256 (TTAB 2009). In *Compagnie*, the Board noted the difference between the above-noted objective facts, not subject to proof, and the allegations made in an application, such as dates of first use and first use in commerce, and allegations relative to acquired distinctiveness, that are not objective facts, but are subject to proof in an inter partes proceeding.

6. *IdeasOne Inc. v. Nationwide Better Health*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1539 (TTAB 2007) (“... under the notice pleading rules applicable to this proceeding opposer is only required to state a valid claim.”); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theaters*, 56 USPQ2d 1538, 1539 (TTAB 2000); *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1205 (TTAB 1997); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711 (TTAB 1993); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1462 (TTAB 1992); *Delta Tire Corp. v. Sports Car Club of America, Inc.*, 186 USPQ 431, 432 (TTAB 1975); and *National Semiconductor Corp. v. Varian Associates*, 184 USPQ 62, 64 (TTAB 1974).

503.03 Leave to Amend Defective Pleading

A plaintiff may amend its complaint within 21 days after service of a motion under Fed. R. Civ. P. 12(b)(6) or with the written consent of every adverse party or by leave of the Board, which is freely given when justice so requires. [Note 1.] See TBMP § 507.02. Thus, plaintiffs to proceedings before the Board ordinarily can, and often do, respond to a motion to dismiss by filing, inter alia, an amended complaint. If the amended complaint corrects the defects noted by the defendant in its motion to dismiss, and states a claim upon which relief can be granted, the motion to dismiss normally will be moot. [Note 2.]

If no amended complaint is submitted in response to a motion to dismiss for failure to state a claim upon which relief can be granted, and the Board finds, upon determination of the motion, that the complaint fails to state a claim upon which relief can be granted, the Board generally will allow the plaintiff an opportunity to file an amended pleading. [Note 3.]

However, in appropriate cases, that is, where justice does not require that leave to amend be given, the Board, in its discretion, may refuse to allow an opportunity, or a further opportunity, for amendment. [Note 4.] See TBMP § 507.02 (regarding motions to amend pleading).

NOTES:

1. See Fed. R. Civ. P. 15(a)(1)(B).

2. *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1537 (TTAB 2007).

3. *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1208 (TTAB 1997) (allowed time to perfect fraud claim); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714